

PATENT
Docket No. 116692005400

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of:

Hiroshi YASUDA *et al.*

Examiner: Quoc A. Tran

Application No.: 10/799,607

Group Art Unit: 2176

Filed: March 15, 2004

Confirmation No.: 8412

For: SYSTEM FOR PROCESSING
HANDWRITTEN DOCUMENT AND
METHOD FOR PROCESSING
HANDWRITTEN DOCUMENT

APPELLANTS' REPLY BRIEF

Mail Stop APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief responds to the Examiner's Answer mailed October 5, 2007.
Appellants file concurrently herewith a request for an oral hearing of this appeal.

ARGUMENT

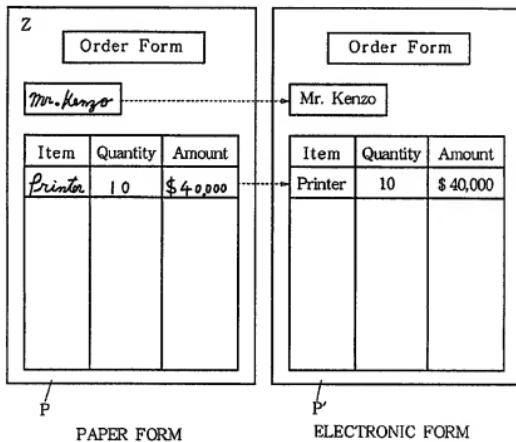
I. Claims 1 and 7

**A. The Examiner's Modified Application of Tsuji To the Printing Claim
Language Is Unsupported and Mischaracterizes Tsuji**

Claims 1 and 7 recite combinations that include printing a document, based on an acquired format, *with* identifier information associated with the format. During prosecution, the Examiner rejected these claims over Tsuji, which generates a printable electronic form based on

a paper form. As shown below, upon generating the electronic form P', Tsuji converts handwritten entries on paper form P into electronic form entries in electronic form P' as they are written with a special input pen:

FIG. 6



Tsuji generates electronic form P' by using form-format data corresponding to a form ID associated with paper form P. For example, the form ID of paper form P in FIG. 6 is listed as "Z", which is located in the upper-left corner of the form. However, as explained in the Appeal Brief, this form ID is not printed - or even displayed - on the printable electronic form P'. Thus, because Tsuji does not print electronic form P' *with* the identifier information as required by claims 1 and 7, Tsuji cannot anticipate claims 1 and 7.

In response to this explanation, the Examiner modified the application of Tsuji to the claim language in the Examiner's Answer as follows:

Since Tsuji's electronic-form preparation program displays characters *corresponding to the characters handwritten into the form P by the input pen 10 in substantially real time* (i.e. character being recognized as handwritten into the form P in real time), and identify a form type by writing a form ID into a predetermined area of a paper form without printing a form ID beforehand, in order to print the a form ID, with the document.

It is noted the claimed "*the printing part prints identifier information, with the document,*" is reasonably interprets as *the characters handwritten into the form P by the input pen 10 in substantially real time* (i.e. character being recognized as handwritten into the form P in real time), and identify a form type by writing a form ID into a predetermined area of a paper form without printing a form ID beforehand, in order to print the a form ID, with the document as taught by Tsuji.

Appellants respectfully traverse. The Examiner's characterization of Tsuji is inaccurate and unsupported by Tsuji, and therefore cannot form a proper basis for anticipating claims 1 and 7.

The section of Tsuji relied upon by the Examiner (paragraph [0082]) relates to an alternate embodiment in which the paper form does not list the form ID as part of the form, as shown above in FIG. 6, but rather has a specific area in which the form ID can be handwritten. In this embodiment, the special input pen is used to handwrite an appropriate form ID rather than trace over an existing form ID on the paper form. This identifies the form ID to the system, which accesses the appropriate form-format data based on this identifier and generates the appropriate electronic form based on this data. Once the electronic form is generated, subsequent handwriting in form entry areas of the paper form are converted to electronic entries in the generated electronic form in substantially real time.

In citing this alternate embodiment, the Examiner reasons that because Tsuji converts handwritten entries on the paper form to electronic entries on the electronic form, then Tsuji would necessarily convert a handwritten form ID on the paper form to an electronic form ID on

the electronic form - which can then be printed as required by claims 1 and 7. Appellants respectfully disagree.

Nothing in Tsuji teaches or suggests that Tsuji would convert a form ID handwritten on the paper form into an electronic form ID in the corresponding electronic form. In fact, Tsuji is *incapable* of such a conversion. As explained above, the electronic form is not generated until the paper form ID is identified and the appropriate form-format data is accessed. Thus, a handwritten paper form ID cannot be converted into an electronic form ID in substantially real time because the corresponding electronic form does not yet exist at the time the paper form ID is handwritten. Further, since Tsuji does not display the form ID in the corresponding electronic form when the special input pen is used to trace a form ID listed on the paper form (as shown in FIG. 6 and explained in the Appeal Brief), there is no reason for Tsuji to display the form ID in the corresponding electronic form when the same pen is used in the same way to instead handwrite a form ID on the paper form.

Accordingly, because Tsuji does not print electronic form P' *with* the identifier information as required by claims 1 and 7, Tsuji cannot anticipate claims 1 and 7 and claims depending thereon.

II. Claim 1

A. Tsuji Does Not Teach or Suggest a Combination Including the Receiving Terminal and Document Receiving Terminal As Claimed

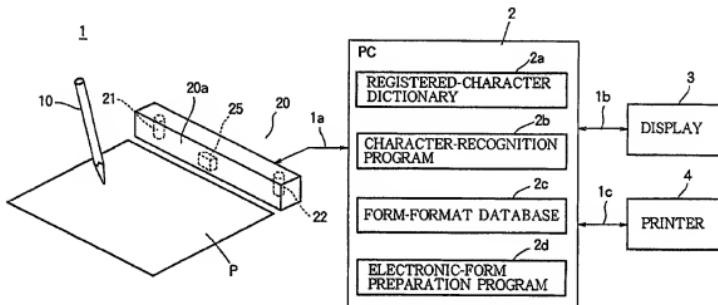
In the Examiner's Answer, the Examiner cited coordinate-input device 1 of Tsuji for teaching the claimed receiving terminal, and the PC (personal computer) 2 of Tsuji for teaching the claimed document receiving terminal. Appellants respectfully traverse.

Claim 1 requires a combination including a receiving terminal configured to acquire handwritten information that is handwritten on a document, and a document receiving terminal configured to receive the handwritten information that is transmitted from the receiving terminal.

The claimed receiving terminal also includes a format acquisition part which acquires the format of the document from a format storage terminal, and a printing part which prints the document based on the format acquired by the format acquisition part.

The electronic-form preparation system of Tsuji is shown as follows:

FIG.1



Because the coordinate-input device 1 of Tsuji – which the Examiner equates with the claimed receiving device – does not include a format acquisition part and printing part as claimed, Tsuji fails to disclose all of the claimed elements, and thus cannot anticipate claim 1 and claims depending thereon.

CONCLUSION

For the foregoing reasons and the reasons set forth in the Appeal Brief, Appellants respectfully request that the Board reverse the rejection of claims 1 and 7 under 35 USC 102(b) as anticipated by Tsuji and the rejection of claims 3, 5-6 and 9-12 under 35 USC 103(a) over Tsuji in view of Lerner.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, Appellants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Docket No. **116692005400**.

Dated: December 5, 2007

Respectfully submitted,

By Alex Chartove
Alex Chartove
Registration No.: 31,942
MORRISON & FOERSTER LLP
1650 Tysons Blvd, Suite 400
McLean, Virginia 22102
(703) 760-7744